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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,870	10/15/2003	Thomas J. Laginess	IN-5698	7421

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EXAMINER

BERMAN, SUSAN W

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/686,870	Applicant(s) LAGINESS ET AL.	
	Examiner Susan W Berman	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/04 & 6/03</u> | 6) <input type="checkbox"/> Other: ____ |

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Claim Objections

Claims 3, 5, 9 and 12 are objected to because of the following informalities: Long spaces between words in claims 3, 5 and 12 raises the issue of whether words have been left out. Claim 9, line 3, contains a misspelling of "benzylketals". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-6 and 11-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no antecedent basis in claims 1 or 11 for the recitations compound "A" and compound "B" in claims 2-6 and 12-14. Claim 3 uses improper Markush language in the phrase "selected from" instead of "selected from the group consisting of". Claim 5 uses improper Markush language in the phrase "selected from the group consisting of...urethane acrylates and unsaturated polyesters and mixtures thereof". The first occurrence of "and" should be deleted. In claims 4 and 14, it is not clear whether applicant intends to claim urethane diacrylates, urethane triacrylates, etc or some other kinds of diacrylates, triacrylates, etc. There is no antecedent basis in claims 1 or 11 for the recitation "urethane acrylates" since the compound in "b" contains two or more ethylenically unsaturated groups. The "polyfunctional acrylates" are not clearly differentiated from the diacrylates and/or triacrylates. Claims 4 and 14 use improper Markush language in line 3; the first occurrence of "and" before "polyfunctional" should be deleted. In claim 6, the polyfunctional urethane acrylates are not clearly differentiated from difunctional urethane acrylates since difunctional urethane acrylates are polyfunctional. Claim 11 uses improper Markush language in step "B"; the first occurrence of "and" before "natural" should be deleted. Claim 12 uses improper Markush language in line 4; the first occurrence of "and" before "esters of acrylic

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acid” should be deleted. Claim 13 uses improper Markush language in line 4; the first occurrence of “and” before “octyl acrylate” should be deleted.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-17, 19 and 20 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 01/74499 (Fenn et al). See page 2, page 5-8, page 9, second paragraph, page 11, first three paragraphs, and the examples. Compositions disclosed by WO ‘499 wherein the weight percents of components are within the instantly claimed ranges and the process of using said compositions anticipate the instant claims.

Claims 1-17, 19 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Fenn et al (6,838,177). See the Abstract, column 1, lines 4-25, column 3, line 29, to column 4, line 62, column 5, lines 13-32, and the examples. Compositions disclosed by Fenn et al wherein the weight percents of

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components are within the instantly claimed ranges and the process of using said compositions anticipate the instant claims.

Claims 1-17, 19 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Fenn et al (US 2003/0059555). See the Abstract, column 1, lines 4-25, column 3, line 29, to column 4, line 62, column 5, lines 13-32, and the examples. Compositions disclosed by Fenn et al wherein the weight percents of components are within the instantly claimed ranges and the process of using said compositions anticipate the instant claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fenn et al (6,838,177). Fenn et al teach polymerization by exposure to UVA light but do not mention polymerization by exposure to natural light conditions. It would have been obvious to one skilled in the art at the time of the invention to substitute natural light exposure for UVA light exposure because natural light provides exposure to UVA radiation. One of ordinary skill in the art at the time of the invention would have been motivated by an expectation that the disclosed compositions would cure when exposed to natural light.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Smith et al (5,407,972) disclose procurable ethylenically unsaturated compounds curable with UVA and

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sunlight in 1 to 5 minutes. Bisphenyl(2,5-dimethylbenzoyl) phosphine oxide is taught as useful photoinitiator.

GB 2 283 975 discloses compositions comprising components equivalent to instantly claimed components a-d and f, wherein the photoinitiator can be a benzylketal. The difference is that GB '975 teaches exposure to UVA for 20 seconds followed by completing the cure by exposure to heat.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 571 272 1067. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Susan W Berman
Primary Examiner
Art Unit 1711

sb
March 19, 2005